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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/056,211	01/28/2002	Satoru Funakoshi	7372/72577	6904

22242 7590 11/20/2003

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CHICAGO, IL 60603-3406

EXAMINER

SIMONE, CATHERINE A

ART UNIT	PAPER NUMBER
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1772

DATE MAILED: 11/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

0010

**Office Action Summary**

Application No.

10/056,211

Applicant(s)

FUNAKOSHI, SATORU

Examiner

Catherine Simone

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. §§ 119 and 120**

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Withdrawn Rejections*

1. The 35 U.S.C. 112 rejection of claims 1-6 of record in Paper #8, Page 2, Paragraph #2 has been withdrawn due to the Applicant's amendment in Paper #9.
2. The 35 U.S.C. 102 rejection of claims 1-4 and 6 as anticipated by Labrie recorded in Paper #8, Pages 2-3, Paragraph #4 has been withdrawn due to the Applicant's amendment in Paper #9.
3. The 35 U.S.C. 103 rejection of claim 5 over Labrie in view of Masubuchi et al. recorded in Paper #8, Pages 3-4, Paragraph #6 has been withdrawn due to the Applicant's amendment in Paper #9.

### *Claim Rejections - 35 USC § 102*

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. **Claims 1, 2 and 6-8** are rejected under 35 U.S.C. 102(b) as being anticipated by Waragai et al. (4,446,185).

Regarding **claims 1 and 8**, Waragai et al. discloses a thermoplastic resin foam molding comprising a substrate (Fig. 1, #1) and a projection (Fig. 1, #2) formed integrally with the substrate from the same material as that of the substrate wherein the substrate has a foam layer

(Fig. 1, #3) and a skin layer (Fig. 1, #4) which contains no voids and which is of the same material as that of the foam layer wherein the ratio (R/L) of the curvature R of a joint between the projection and the substrate to the thickness L of the skin layer is inherently from 3 to 50 (see Fig. 9). Regarding **claim 2**, note the foam layer of the substrate has a density of 0.7 g/cm<sup>3</sup> or less (see col. 8, lines 6-8 and lines 33-35). Regarding **claim 6**, it is an intended use recitation and it has been held that a recitation with respect to the manner in which a claimed product is intended to be employed does not differentiate the claimed product from a prior art product satisfying the claimed structural limitations. *Ex parte Masham*, 2 USPQ2d 1647 (1987). Regarding **claim 7**, note the projection (Fig. 1, #2) is formed integrally with the substrate (Fig. 1, #3) from the same material as that of the substrate.

### ***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. **Claims 3 and 4** are rejected under 35 U.S.C. 103(a) as being unpatentable over Waragai et al. (4,446,185).

Regarding **claims 3 and 4**, Waragai et al. discloses the claimed invention except for the joint between the substrate and projection having a foamed ratio of from 1 to 1.3 and the projection having an average foamed ratio of from 1 to 1.3 times. Although, Waragai et al. does teach in Fig.1 a showing of a joint between the substrate and the projection having a foamed ratio

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and a projection having a foamed ratio. However, Waragai et al. fails to teach the specific claimed foamed ratio for the joint between the substrate and the projection and the specific claimed average foamed ratio for the projection. One of ordinary skill in the art would have recognized the foamed ratio for the joint between the substrate and the projection to be of from 1 to 1.3 times and the average foamed ratio for the projection to be of 1 to 1.3 times as shown by Fig. 1 of Waragai et al. Therefore, the one of ordinary skill in the art would have readily determined the foamed ratio of the joint between the substrate and the projection and the average foamed ratio of the projection depending on the desired end results. Thus, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified in Waragai et al. the joint between the substrate and projection to have a foamed ratio of from 1 to 1.3 and the projection to have an average foamed ratio of from 1 to 1.3 times, since one of ordinary skill in the art would have readily determined the desired foamed ratio for the joint between the substrate and the projection and the desired average foamed ratio for the projection depending on the desired end results as shown by Figure 1 of Waragai et al.

8. **Claim 5** is rejected under 35 U.S.C. 103(a) as being unpatentable over Waragai et al (4,446,185) in view of Masubuchi et al (EP 0 925 895).

Waragai et al discloses a thermoplastic resin foam molding comprising a substrate (Fig. 1, #1) and a projection (Fig. 1, #2) formed integrally with the substrate from the same material as that of the substrate wherein the substrate has a foam layer (Fig. 1, #3) and a skin layer (Fig. 1, #4) which contains no voids and which is of the same material as that of the foam layer. However, Waragai et al. fails to disclose the thermoplastic resin being a propylene-based resin whose Izod impact value at 23°C is 10 KJ/m<sup>2</sup> or more. Masubuchi et al teaches it is old and well-

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known in the analogous art to have a propylene-based resin whose Izod impact value at 23°C is 10 KJ/m<sup>2</sup> or more (see page 3, lines 7-18) for the purpose of producing a thermoplastic resin foam molding.

Therefore, it would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have modified the resin in Waragai et al. to be of a propylene-based resin whose Izod impact value at 23°C is 10 KJ/m<sup>2</sup> or more as suggested by Masubuchi et al in order to produce a thermoplastic resin foam molding.

### *Response to Arguments*

9. Applicant's arguments with respect to claims 1-8 have been considered but are moot in view of the new ground(s) of rejection.

### *Conclusion*

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Catherine Simone whose telephone number is (703)605-4297.

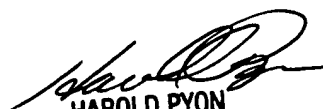
The examiner can normally be reached on 9:30-6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Harold Pyon can be reached on (703) 308-4251. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9311.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.



Catherine Simone  
Examiner  
Art Unit 1772  
November 14, 2003



HAROLD PYON  
SUPERVISORY PATENT EXAMINER  
1772

11/14/03